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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,868	06/15/2001	Chidambaram Krishnan	010362	8522

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Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

EXAMINER

MOORTHY, ARAVIND K

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,868

Applicant(s)

KRISHNAN ET AL.

Examiner

Aravind K. Moorthy

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-53 is/are pending in the application.
- 4a) Of the above claim(s) 1-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the amendment filed on 2 March 2005.
2. Claims 34-53 are pending in the application.
3. Claims 34-53 have been rejected.
4. Claims 1-33 have been cancelled.

Response to Amendment

5. The examiner approves the amendment made to the abstract. The abstract no longer exceeds the 150-word limit.

Response to Arguments

6. Applicant's arguments with respect to claims 34-53 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

7. Claims 51 and 52 are objected to because of the following informalities: improper dependency.

A claim cannot depend upon itself. As recited, claim 51 depends upon claim 51 and claim 52 depends upon claim 52. For the sake of examining, the examiner assumes that claim 51 depends upon claim 50 and claim 52 depends upon claim 51.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 34, 36-38, 40-48 and 50-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolev et al U.S. Patent No. 6,125,283.

As to claim 34, Kolev et al discloses a Subscriber Identity Module (SIM) adapted for and powered by a wireless communication device (WCD), the WCD including a power management routine and a memory, the SIM comprising:

means for storing a first unique identifier [column 6, lines 18-41];

means for accessing the first unique identifier at an initial power up of the WCD to permit access to the SIM by the WCD and enable the first unique identifier to be stored in the memory of the WCD [column 8, lines 6-21];

means for receiving a second unique identifier at a subsequent power up of the SIM, the SIM having been powered down under control of a power management routine performed by the WCD [column 8 line 22 to column 9 line 34];

means for comparing the second unique identifier received from the WCD to the first unique identifier [column 8 line 22 to column 9 line 34]; and

means for enabling access of the SIM by the WCD based on the comparison [column 8 line 22 to column 9 line 34].

As to claims 36 and 37, Kolev et al discloses that the SIM includes an interface circuit for interfacing with the WCD [column 9, lines 34-53]. Kolev et al discloses the interface circuit terminating power to the SIM during powering down [column 9, lines 34-53].

As to claim 38, Kolev et al discloses a WCD including a power management routine and a memory and adapted for use with a SIM, the WCD comprising:

means for storing in the memory a first unique identifier generated in response to an initial power up of the WCD permitting access to the SIM by the WCD [column 6, lines 18-41];

means, responsive to the power management routine, for powering down the SIM [column 9, lines 34-53];

means responsive to the power management routine for powering up the SIM [column 9, lines 34-53];

means for transmitting the first unique identifier to the SIM [column 9, lines 34-53]; and

means for detecting access to the SIM in response to the SIM matching the first unique identifier from the WCD to a second unique identifier stored in the SIM [column 9, lines 34-53].

As to claims 40, 41 and 53, Kolev et al discloses that the SIM includes an interface circuit for interfacing with the WCD [column 8, lines 6-21]. Kolev et al discloses the means for powering up the SIM including providing power to the SIM [column 8, lines 6-21].

As to claims 42, 45 and 50, Kolev et al discloses that the power management routine continues a power management cycle by maintaining power to the SIM when a match occurs, and aborts the power-up process when a match fails [column 8, lines 6-21].

As to claims 43, 46 and 51, Kolev et al discloses that the power management routine terminates power to the SIM in response to a power down command and on the basis of a voting process [column 9, lines 34-53].

As to claims 44, 47 and 52, Kolev et al discloses that terminating power to the SIM comprises terminating power to the SIM when no request is pending for service by the SIM and no software module running on the WCD requests maintenance of power to the SIM [column 9, lines 34-53].

As to claim 48, Kolev et al discloses a computer-readable medium having instructions, including a power management routine, stored thereon for causing a WCD having a memory and adapted for use with a SIM to:

store in the memory a first unique identifier generated in response to an initial power up of the WCD permitting access to the SIM by the WCD [column 8 line 22 to column 9 line 34];

power down the SIM in response to the power management routine
[column 8 line 22 to column 9 line 34];

power up the SIM in response to the power management routine [column
8 line 22 to column 9 line 34];

transmitting the first unique identifier to the SIM [column 8 line 22 to
column 9 line 34]; and

detecting access to the SIM in response to the SIM matching the first
unique identifier from the WCD to a second unique identifier stored in the SIM
[column 8 line 22 to column 9 line 34].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 35, 39 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koley et al U.S. Patent No. 6,125,283 as applied to claims 34, 38 and 48 above, and further in view of Tushie et al U.S. Patent No. 6,014,748.

As to claims 35, 39 and 49, Koley et al teaches identifiers [column 6, lines 18-41].

Koley et al is silent as to what type of identifiers the SIM employs.

Tushie et al teaches first and second unique identifiers that are Integrated Circuit Card Identifiers (ICCID) [column 18, lines 50-60].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Kolev et al so that the identifier would have been ICCIDs.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Kolev et al by the teaching of Tushie et al because the identifiers permit the system to address data stored in a data structure, such as a database, and specify the particular data needed by the system for each card to be issued [column 2, lines 46-65].

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aravind K Moorthy *AM*
May 16, 2005

Ayaz Sheikh
AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
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